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UNITED STATES DISTRICT COURT

NORTHERN DISTRICT OF CALIFORNIA

SAN FRANCISCO DIVISION

ORACLE AMERICA, INC.,

Plaintiff,

v.

GOOGLE INC.,

Defendant.

Case No. 3:10-cv-03561-WHA

GOOGLE'S STATEMENT RE THE COURT'S DECEMBER 5, 2011 SUPPLEMENTAL ORDER REGARDING PATENT MARKING

Judge: Hon. William Alsup

Google hereby makes this response to the Court's Order Regarding Patent Marking (Dkt. No. 636). Google did not previously file any statement because Google agreed that there was no cause why an order should not be entered.

Google believes that the procedure set forth in the Court's order is appropriate because it comports with the legal standard for proof of marking. Under Federal Circuit law, the patentee bears the burden of showing compliance with the marking statute. *See Nike, Inc. v. Wal-Mart Stores, Inc.*, 138 F.3d 1437, 1446 (Fed. Cir. 1998). The patentee also bears the burden of proving that it did ***not*** practice a patent if it takes that position. *See DR Systems, Inc. v. Eastman Kodak Co.*, No. 08-cv-066920, 09 WL 2632685 at *4 (S.D. Cal. Aug. 24, 2009) ("patentees must also have the burden of proving the nonexistence of patented articles." (citing *Soverain Software LLC v. Amazon.com, Inc.*, 383 F. Supp. 2d 904, 908 (E.D. Tex. 2005))); *see also WiAV Solutions LLC v. Motorola, Inc. et al*, 732 F. Supp. 2d 634, 640 (E.D. Va. 2010) (the patentee "bears the burden of showing that it, and its licensees, were not required to mark under § 287").

Once Oracle has addressed the issue in its December 16, 2011 submission, Google has no objection to also setting forth its position on marking. Google accepts the Court's directive that it identify with particularity any further Oracle products that Google contends practice the patents and why. Google also accepts Oracle's suggestion that Google state its contentions regarding any Oracle products that Google contends do not practice the patents. But importantly, even if Google discloses its position regarding the products identified in Oracle's disclosure, the burden of proof at trial still will remain with Oracle as to whether its products did or did not practice the asserted patents.

Finally, Google has one further suggestion in light of Oracle's December 2, 2011 letter to the Court. In order to properly allocate the burden of proof, require the same level of detail from both parties' submissions, and ensure that this procedure provides the most assistance to the parties and the Court, Google requests that the Court direct Oracle, in its December 16, 2011 submission, to state with particularity its contentions that any of the products it identifies practice the asserted patents, and the evidentiary basis for any such contentions. This level of detail is essential for this process to work effectively. The disclosure by Google that Oracle requests, and

that Google is willing to provide, will be largely contingent on the nature of Oracle's December 16, 2011 disclosure. To put Google in a position to respond meaningfully, Oracle should state positions that are specific, straightforward and based on evidence it has properly identified in its previous disclosures under Patent L.R. 3–1(g). Then, after reviewing Oracle's submission, Google will submit its response on December 30, 2011.

Dated: December 5, 2011

KEKER & VAN NEST LLP

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